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DEC 27 2005

In re Application of: Buckley, et al.)
Application No.: 10/042,987)
Filed: January 11, 2002)
Attorney Docket No.: D/A1651)
For: METHOD FOR DOCUMENT)
VIEWING)
)
)
)

Technology Center 2100

**DECISION ON PETITION UNDER 37
CFR §1.181**

This is a decision on the petition filed October 7, 2005, under 37 CFR §1.181, to invoke the Commissioner's supervisory authority and instruct the Examiner to withdraw the Office action dated October 4, 2005 and issue a proper notice of panel decision from pre-appeal brief review.

A petition under this section must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. The petition filed October 7, 2005 includes elements (1) and (2) above.

The petition is **DISMISSED as moot**.

RECENT PROSECUTION HISTORY

On April 20, 2005, the Examiner issued a Non-Final Office action, rejection all pending claims 7-16.

On June 17, 2005, a response and remarks were filed.

On July 15, 2005, a Notice of Appeal and a request for a Pre-Appeal Brief conference was filed.

On October 4, 2005, the Examiner issued a Non-Final Office action, again rejecting all pending claims 7-16.

On October 7, 2005, the instant petition was filed.

On October 31, 2005, an Appeal Brief was filed.

RELIEF REQUESTED

The instant petition under 37 CFR 1.181 requests the following relief: to withdraw the Non-Final Office action dated October 4, 2005 and issue a proper notice of panel decision from pre-appeal brief review.

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Highlighting is added to draw attention to critical phrases.

1204.01 [R-3] > Reinstatement of Appeal

If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. Any previously paid appeal fees set forth in 37 CFR 41.20 for filing a notice of appeal, filing an appeal brief, and requesting an oral hearing (if applicable) will be applied to the new appeal on the same application as long as a final Board decision has not been made on the prior appeal. If, however, the appeal fees have increased since they were previously paid, then appellant must pay the difference between the current fee(s) and the amount previously paid. Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal. See MPEP § 1205.

1207.01 [R-3] **> Appeal Conference<

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § *-> 1205<) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary. >In this case, the examiner may reopen prosecution and issue another Office action. See MPEP § 1207.04.<

United States Patent and Trademark Office OG Notices: 12 July 2005 (reproduced in part below):

New Pre-Appeal Brief Conference Pilot Program. Effective Date: Effective upon publication of this notice. Effective immediately, the USPTO is offering applicants an optional procedure to review the examiner's rejection *prior to* the actual filing of an appeal brief. Although this procedure will not be appropriate in every appealed application, in the proper situations it can save both the resources of the applicant and the Office.

This pilot program offers applicants an opportunity to request a review of identified matters on appeal employing an appeal conference currently employed in the Office, but *prior to* the filing of an appeal brief. The goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a *prima facie* rejection.

If applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review, the review process will end and a decision will not be made on the merits of the request:

- *an appeal brief*
- a request for continued examination (RCE)
- an after-final amendment
- an affidavit or other evidence
- an express abandonment.

To the extent any purely administrative action such as this is petitionable for supervisory review by the TC Director, the pre-appeal brief review panel decision procedure is as well. However, in the absence of promulgated rules, such a petition is problematic as this procedure is a *pilot program* and the USPTO TC's have a wide degree of flexibility in implementing and administering the program, since this is one of the points of the pilot i.e. to try various ways of implementing to determine what works. Further, since the primary purpose of the pre-appeal brief review panel is to " identify the presence or absence of clearly improper rejections based upon error(s) in facts", it would appear, based upon the reopening of prosecution in the Non-Final Office action of October 4, 2005, that Applicant ultimately received the requested relief sought after in the instant petition.

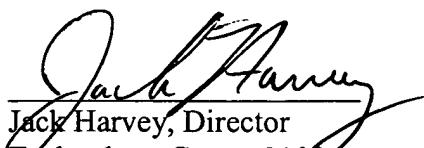
Finally, as an Appeal Brief was filed on October 31, 2005, the instant application does not comply with one of the provisions of the *pilot program* (identified above), i.e. that the panel decision conference must occur *prior to* the filing of an Appeal Brief. If the brief is determined to be acceptable, the Examiner is instructed to proceed in accordance with MPEP §1207.01.

Therefore, in response to the relief requested, it is not possible to grant a request for reinstatement of a notice of panel decision from pre-appeal review. However, an Applicant reserves the right, in this situation, i.e. in response to a subsequent (new) Non-Final Office action, to file a new Notice of Appeal with a further request for pre-appeal brief conference panel review (*prior to* filing an Appeal Brief).

In view of the above stated reason, the instant petition, filed under 37 CFR §1.181 to invoke supervisory authority, is rendered moot.

Accordingly, the petition is **DISMISSED as MOOT.**

The application is being forwarded to the Examiner for consideration of the propriety of the Appeal Brief filed October 31, 2005, in light of MPEP § 1204.01 and 1205. Telephone inquiries should be directed to the undersigned at 571-272-3595.



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